

A2

32. (Amended) The process according to claim 31, wherein said linear rods or
[barshave] bars have a diameter of 2 to 2.5 mm.

REMARKS

New Claim 21 includes the feature of hardening of the resin, and in the response received December 23, 1996, mailed December 18, 1996, in the parent Application, Claim 1 was also amended to add the limitation of hardening of the resin. With respect to the Examiner's statement of reason for allowance, as set forth on page of the paper having a date of February 15, 1997, and mailed on February 19, 1997, it is believed that the Examiner is referring to the statement "...where rear face of the stone material was substantially smooth and free from grooves or recesses..." It should be noted that these words or terms are in parenthesis, and therefore can be considered not to change the meaning if omitted. Generally, the words within a parenthesis can be considered to be a qualifying or amplifying phrase inserted within written matter to be independent of the surrounding grammatical structure.

It should be noted that Claim 7 alone was never allowed in the parent of this Reissue Application. Claim 7 subject matter was added to Claim 1 to complete the background for the amendment of Claim 1, which Applicant argued was the reason for allowability. Note also, Claim 7 subject matter which was rejected by the Examiner, see top of page 7 of the Official Action of August 19, 1996, was rejected over prior art, and therefore the addition of this subject matter or limitation did not make Claim 1 allowable, but the Amendment of adding the hardening of the resin did make the Claim allowable. With respect to the hardening of the resin, this made Claim 1 technically allowable and the addition of Claim 7 took care of the 112 rejections to make Claim 1 formally allowable.

Consideration has been given to *Ball Corp. v. United States* 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984), but the Examiner should respectfully note page 295, column 1, which provides:

The subject matter of the Claims is not alone controlling. Similarly, the focus is not as the Government contends, on the specific limitations or on the elements of the Claims, but rather on the scope of the Claims.

It should be noted that the Claims in the Reissue Applications are intermediate in scope, i.e. ---broader than the Claims of the original Patent, and --- yet narrower than the canceled Claims; note that the decision cited by the Examiner supports this proposition.

Also, please note that the Reissue Claims 21 - 38 include limitations note present in the canceled Claims.

Note that this Reissue Application was filed within the two year period provided for filing a broadened Reissue Claim as specified in Sections 251.

It should be noted that the Claims are all directed to a process so that the structural features in Claim 1, which are omitted from Claim 21, are a narrowing limitation, and the omission of the statement:

“...having a rear substantially smooth face free of grooves or recess..”, is a broadening of the Claim, and this should have not effect because no specific reference was made in the Specification.

For this purpose, the Examiner is respectfully referred to: *In re Peters and Anderson*, 221 U.S.P.Q. 952, 954 (Fed. Cir. 1984) which held that:

where “...overall disclosure reasonably conveys to one skilled in the art that inventor had possession of broad invention at time original Application was filed, claim drawn to that invention is available upon compliance with all provisions of 35 U.S.C. 251...”

With respect to the reasons for allowability, it was further **error (page 5)** for Applicant to agree to the reasons for allowability when the only limitation added to the combination of the subject matter of Claims 1 and 8 was ---the hardening of the resin--- because previously, neither Claim 1 subject matter, nor the Claim 8 subject matter was allowable.

The broadened Claims merely omit an unnecessary limitation that had restricted one element of the invention to the exact and non-critical shape disclosed in the original Patent. Clearly, nothing in the original disclosure indicates or suggests that the rear face be -a rear substantially smooth face of grooves or recesses.

Therefore, Claims 21 - 38 are not an improper capture or recapture of claimed subject matter deliberately canceled in the Application. Clearly, 35 U.S.C. 251 is intentionally based on the principle to allow Applicant to do what Applicant has done when this Application was filed.

Reconsideration of this Application is in view of the amendments for the Claims and arguments submitted is respectfully solicited.

With respect to paragraph 1 of the Official Action, and the objections based on improper recapture of claimed subject matter deliberately canceled, Applicant respectfully dissents.

In accordance with MPEP 1410.01 and 37 C.F.R. 1.172, it should be noted that there is no assignee of the subject matter of this Application or the parent Patent.

Applicant respectfully submits that it will surrender its original U.S. Patent 5,670,007, upon a Patent being granted on this Reissue Application.

Claims 21 - 25 were rejected as unpatentable over E.P. 255,795 in view of Japanese

Patent 3-247,852 and optionally further taken with Japanese Patent 6-64076.

Considering the '795 Patent, while it is true that a roving is used, there is no teaching nor suggestion anywhere in this disclosure of providing a "slab of stone material having a rear substantially smooth face." All that is disclosed is that a reinforcement is necessary.

Japan Publication 3,247,852 was cited to show a teaching of reinforcing an artificial or natural stone panel with resin impregnated fibers. This Patent is concerned with impregnating the plaster resin into chopped strand mat and cloth. Note, the disclosure states that the "FRP layer is formed by laminating the mat and cloth on the stone panel and coating the mat and cloth on the stone panel and coating the mat and cloth with the impregnating resin.

Contrast this with Claim 21, which provides for --providing a layer of non-twisted linear glass reinforcing elements applied to the rear face--. The Japanese '852 specifically sets forth that the FRP layer is laminated - Claim 21 does not call for any laminating... The Examiner specifically states that the '852 is used to demonstrate that resin is less than the stone material.

With respect to Japanese Patent 6-64076 ('076) layers 102 and 104 are not equivalent to Applicant's Claim 21. Layer 102 is a fiber reinforced resin layer and 104 is a reinforced resin layer.

Claim 21 calls for a full layer of non-twisted linear glass reinforcing elements, and then a second layer is applied as a coating of resin. Layer 104 which is the second layer and includes a matrix resin 6 with reinforcing fibers 4 interwoven into a cloth --therefore, the second layer is different. With respect to the first layers - or resin layer 102; this layer also includes reinforcing fibers 2. The Examiner has completely reconstructed the wording and

process steps of this Claim. Yes, there are two coatings, the material is different. There is no teaching of a rear substantially smooth face.

Clearly, there is no teaching of the features of Claims 21 - 25. Also there is no suggestion in any of the references of record as to how they should be modified as suggested by the Examiner.

Turning now to paragraph 6, and the rejection of Claims 1 - 20 and 26 - 38, the Examiner has added European Patent 631,015 ('015).

The EP '015 adds grooves. Note, with respect to the Reissue Claims, the only ones that have grooves or recesses are 28 and 29.

Note that 10 is the slab of stone material, and the grooves 12 are formed in the stone material. Claim 26 sets forth that the --linear reinforcing elements are inserted between the reinforcement layer and the rear face of the slab. Claim 28 calls for grooves or recess formed in the rear face of the slab. Therefore, since Claim 21 is not rendered obvious by any combination of the first-three references, the adding of the '015 Patent because of the grooved grid structure does not render Claims 28 and 29, nor Claims 1 - 20 or 26 - 38, obvious.

Attached is a One-Month Term Extension, together with a check in the amount of \$110.00. Should the One-Month Term Extension, or the check for \$110.00 become detached, please take this as your authorization to take a one-month term extension, and charge the fee of \$110.00 to our Deposit Account 13-0025.

Also, please note that the firm name has changed; it should now read as follows:

McAULAY NISSEN GOLDBERG & KIEL, LLP

Early and favorable consideration is respectfully solicited.

Respectfully submitted,
McAULAY NISSEN GOLDBERG & KIEL, LLP

Dated: April 17, 2000
261 Madison Avenue
New York, NY 10016
(212) 986-4090
JHN:rm
Enclosures:

By J. Harold Nissen
J. Harold Nissen
Reg. 17,283

Request for One-Month Term Extension
Check in the Amount of \$110.00